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FROM: H. Artoush Ohanian, Reg. No. 46,022

RE: Reply Brief to Examiner's Answer dated March 16, 2006;
Title: "Origin Device Based Caller Identification"
Atty. Docket No.: AUS920010818US1 (124)

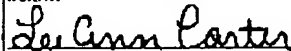
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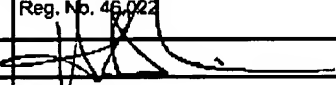
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	First Named Inventor	Michael W. Brown	
	Art Unit	2845	
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In re Application of:
Michael W. Brown, *et al.*

Serial No.: 10/015,381

Filed: December 12, 2001

Title: Origin Device Based Caller
Identification

§
§ Group Art Unit: 2645
§
§ Examiner: Elahee, MD S.
§
§ Atty Docket No.: AUS920010818US1
§
§
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§

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May 16, 2006

Date

Lee Ann Carter
Lee Ann Carter

REPLY BRIEF

Honorable Commissioner:

This is a Reply Brief to the Examiner's Answer of March 16, 2006, pursuant to 37 CFR § 41.41. The Appeal Brief was filed pursuant to 37 CFR § 41.37 on December 16, 2005, in response to the Final Office Action of July 6, 2005, and pursuant to the Notice of Appeal filed October 6, 2005.

REAL PARTY IN INTEREST

The real party in interest is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

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RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 31-41 are pending in the case. All pending claims are on appeal.

STATUS OF AMENDMENTS

No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Reply Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants provide the following concise summary of the invention according to 37 CFR 1.192(c)(5). Methods, systems, and computer program products are provided for specifying telephone services for a particular caller. Embodiments include receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile described for example with reference to Figure 4, steps 1-6 at pages 31, line 5- page 33, line 5, page 14, lines 5 - 15; page 20, lines 21 - page 22, line 20; and page 25, line 1 - page 26, line 5.

All such references to the specification identify descriptions and discussions that are part of the detailed descriptions of exemplary embodiments of the present invention in the present application. Such descriptions and discussions are not limitations of the claims in the present application. The only limitations of the claims are set forth in the claims themselves.

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NEW GROUNDS OF REJECTION

1. Additional references in Bouvier are cited in the Examiner's Answer in an attempt to cure the deficiencies of Bouvier to disclose each and every element or enable claims 31, 33, 35, 37, 39, and 40 within the meaning of 35 U.S.C. § 102.
2. Additional references in Bouvier are cited in the Examiner's Answer in an attempt to cure the deficiencies of Bouvier in combination with Moser to establish a prima facie case of obviousness against claims 32 and 36 according to 35 U.S.C. § 103.
3. Additional references in Bouvier are cited in the Examiner's Answer in an attempt to cure the deficiencies of Bouvier in combination with Kawahara to establish a prima facie case of obviousness against claims 34, 38, and 41 according to 35 U.S.C. § 103.

ARGUMENT

Applicants present the following arguments pursuant to 37 CFR § 41.37(c)(1)(vii) regarding the three new grounds of rejections in the present case.

FIRST NEW GROUND OF REJECTION: ADDITIONAL REFERENCES IN BOUVIER ARE CITED IN THE EXAMINER'S ANSWER IN AN ATTEMPT TO CURE THE DEFICIENCIES OF BOUVIER TO DISCLOSE EACH AND EVERY ELEMENT OR ENABLE CLAIMS 31, 33, 35, 37, 39, AND 40 WITHIN THE MEANING OF 35 U.S.C. § 102

Claims 31, 33, 35, 37, 39, and 40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bouvier *et al.* (U.S. Patent No. 6,430,276) in the Final Office Action of July 6, 2005. To anticipate claims 31, 33, 35, 37, 39, and 40 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Bouvier must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Bouvier must enable Applicants' claims. The Appeal

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Brief dated December 16, 2005 presented arguments that Bouvier does not meet either requirement and therefore does not anticipate Applicants' claims. In response to the Appeal Brief, the Examiner's Answer cites additional references in Bouvier in an attempt to demonstrate that Bouvier does anticipate the Applicants' claims within the meaning of 35 U.S.C. § 102(e). As explained in detail below, the additional references cited in Bouvier by the Examiner's Answer do not meet the requirements of anticipation, and the rejection should be withdrawn.

Bouvier Does Not Disclose Each And
Every Element Of Claim 31

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Bouvier generally discloses selecting a dialup Internet provider for a particular caller and does not disclose each and every element of claim 31. Independent claim 31 of the present application claims:

31. A method for specifying telephone services for a particular caller, comprising:

receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device;

retrieving a caller profile for said authenticated caller identity; and

specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.

Bouvier Does Not Disclose Receiving, At An Intermediary Device, An
Authenticated Caller Identity For A Call Request From An Origin Device

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The first element of claim 31 claims "receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device...." The Final Office Action relies on Bouvier at Figure 1, column 5, line 65 through column 6, line 13, in an effort to show that Bouvier discloses the first element of claim 31. In response to the Final Office Action, the Appeal Brief explains that Figure 1 only illustrates that a public switched network, a public internet, a private intranet, and an extranet may coexist. The Appeal Brief further explained that Bouvier at column 5, line 65 through column 6, line 13, did not even address authenticated caller identities, call requests, or specifying telephone services for a particular caller. As such, Applicants argued in the Appeal Brief that Bouvier does not disclose each and every element of claim 31 and the rejection should be withdrawn.

The Examiner's Answer at page 9 responds to the arguments in the Appeal Brief regarding the first element of claim 31 stating:

On pages 10 and 11 of the Appeal Brief, the Appellant contends that Figure 1 does not disclose receiving, at an intermediary device, an authenticated caller identify for a call request from an origin device as claimed in the present invention. Examiner respectfully disagrees with this argument. The Appellant didn't claim the actual physical location of intermediary device and origin device. The service control subsystem of Bouvier reads on the claimed 'intermediary device' and the customer telephone reads on the claimed 'origin device.' It is because, the service control subsystem receives a Personal Identification Number (PIN) for a call request from a customer telephone (col.5, line 65-col. 6., line 13, col. 7, lines 9-31).

That is, the Examiner's Answer now argues that Bouvier at column 7, lines 9-31, discloses the first element of claim 31. Applicants respectfully note in response, however, that Bouvier at column 7, lines 9-31, in fact discloses:

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The application first initiates a user identification or authentication procedure to verify the identity of the calling party. Different procedures may be used. In one embodiment, the SCP issues a ConnectToResource message to the switch requesting that the calling user be connected to an Intelligent Peripheral (IP). A further 'PromptAndCollectUserInformation' message is sent to the switch in accordance with the Core INAP protocol to collect the user's subscriber number and the PIN code. The information collected is returned back to the SCP in a TCAP result message where a lookup is done in database 50 to check the subscriber number and PIN code against a list of valid pairings. Alternatively, the user authentication may use a procedure based on a calling card. In this case, the calling party is identified by the calling card used, and the billing charge for the connection will be charged to that calling card. In this case, the calling card number will be retrieved using specific calling card reading equipment, although the calling party may still be requested to enter a PIN number.

Once the SCP has authenticated the calling user, the User Access options (user profile) that is contained in the centralised database 50 is retrieved by the application.

That is, Bouvier at column 7, lines 9-31, discloses authenticating a user using a PIN or calling card and retrieving user access options from a database. Bouvier's authenticating a user using a PIN or calling card and retrieving user access options from a database is not receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device as claimed in the present application. In fact, Bouvier at column 7, lines 9-31, does not even mention 'an intermediary device,' 'an authenticated caller identity,' or 'receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device.' Because the additional citation to Bouvier in the Examiner's Answer do not disclose each and every element of the Applicants' claims,

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Bouvier does not anticipate the Applicants' claims, and the rejections should be withdrawn.

In addition to citing Bouvier at column 7, lines 9-31, the Examiner's Answer argues above that a service control subsystem ('SCP') is an intermediary device as claimed in the present application. The service control subsystem of Bouvier, however, is not an intermediary device as claimed in the present application. Bouvier at column 7, lines 9-31, describes the SCP as receiving PIN numbers used to authenticate a calling user—not receiving an authenticated caller identity for a call request from an origin device. That is, the SCP of Bouvier receives only PIN numbers used to authenticate, the SCP of Bouvier does not receive an already authenticated caller identity for a call request from an origin device. Because the additional citation to Bouvier in the Examiner's Answer do not disclose each and every element of the Applicants' claims, Bouvier does not anticipate the Applicants' claims, and the rejections should be withdrawn.

Bouvier Does Not Disclose Specifying A Selection Of Services
From Among A Plurality Of Services That Are Offered For
Said Call Request According To Said Caller Profile

The third element of claim 31 claims "specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile." The Final Office Action relies on Bouvier at column 6, lines 11-16, and the theory of inherency to disclose the third element of claim 31. In response to the Final Office Action, the Appeal Brief explains that column 6, lines 11-16, is a general description of identifying a particular customer and retrieving a customer profile that does not even address services offered for a call request or specifying telephone services for a particular caller at all. The Appeal Brief further explains that the Final Office Action cannot rely on the theory of inherency to disclose the third element of claim 31 because the Final Office Action does not provide the required analysis under *Ex parte Levy* to support a rejection on the theory of inherency. 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990). As

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such, Bouvier does not disclose each and every element of claim 31 and the rejection should be withdrawn.

The Examiner's Answer at pages 7 and 8 responds to the arguments in the Appeal Brief regarding the first element of claim 31 stating:

Since user is provided with different access options through telephone from which he/she can make a choice and each of user's choice corresponds to a network access server (col. 7, lines 39-50), the 'different access option though telephone' is the claimed 'specifying telephone services.' Thus the rejection of the claims in view of Bouvier is proper.

That is, the Examiner's Answer now argues that Bouvier at column 7, lines 39-50, discloses the third element of claim 31 in the present application. Applicants respectfully note in response, however, that Bouvier at column 7, lines 39-50, in fact discloses:

The different options that are available are then presented to the user. This is achieved by means of the 'PromptAndCollectUserInfo' message sent by the application to the switch. This message causes the switch to instruct an Intelligent Peripheral (IP) to present the user with the different access options which the customer may choose. The user chooses which option he/she wants and the choice of the user is returned back to the application by means of a TCAP result message. The application running on the SCP will map the user's choice onto a real phone number corresponding to a network access server of a particular access service provider.

That is, Bouvier at column 7, lines 39-50, discloses presenting a user with possible dialup Internet providers and mapping the user to one of the dialup Internet providers. Bouvier's presenting a user with possible dialup Internet providers and mapping the user to one of the dialup Internet service providers is not specifying a selection of services

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from among a plurality of services that are offered for said call request according to said caller profile according to embodiments of the present invention. Bouvier at column 7, lines 39-50, merely describes connecting a user to one of several dialup Internet providers. A dialup Internet dial-up provider is a provider of Internet access. By contrast, the present application claims specifying telephone services for a particular caller. In addition to not disclosing specifying telephone services of the present application, Bouvier at column 7, lines 39-50, does not mention 'a caller profile' or 'specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.' Because the additional citations to Bouvier in the Examiner's Answer do not disclose each and every element of the Applicants' claims, Bouvier does not anticipate the Applicants' claims, and the rejections should be withdrawn.

The Examiner's Answer at page 8 also responds to the arguments in the Appeal Brief regarding the third element of claim 31 stating:

On page 6, of the Appeal Brief, the Appellant further contends that the cited sections of Bouvier do not even address authenticated caller identities, call requests, or specifying telephone services for a particular caller at all. Examiner respectfully disagrees with this argument. Bouvier teaches that a particular customer is identified by his PIN and his profile is retrieved after being identified by SCP of service control subsystem (col. 6, lines 7-16, col. 7, lines 9-31).

That is, the Examiner's Answer now argues that Bouvier at column 7, lines 9-31, discloses the third element of claim 31 in the present application. Applicants respectfully note in response, however, that Bouvier at column 7, lines 9-31, in fact discloses:

The application first initiates a user identification or authentication procedure to verify the identity of the calling party. Different procedures may be used. In one embodiment, the SCP issues a ConnectToResource

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message to the switch requesting that the calling user be connected to an Intelligent Peripheral (IP). A further 'PromptAndCollectUserInformation' message is sent to the switch in accordance with the Core INAP protocol to collect the user's subscriber number and the PIN code. The information collected is returned back to the SCP in a TCAP result message where a lookup is done in database 50 to check the subscriber number and PIN code against a list of valid pairings. Alternatively, the user authentication may use a procedure based on a calling card. In this case, the calling party is identified by the calling card used, and the billing charge for the connection will be charged to that calling card. In this case, the calling card number will be retrieved using specific calling card reading equipment, although the calling party may still be requested to enter a PIN number.

Once the SCP has authenticated the calling user, the User Access options (user profile) that is contained in the centralised database 50 is retrieved by the application.

That is, Bouvier at column 7, lines 9-31, discloses authenticating a user using a PIN or calling card and retrieving user access options from a database. Bouvier's authenticating a user using a PIN or calling card and retrieving user access options from a database is not specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile according to embodiments of the present invention. The user access options of Bouvier are dialup Internet providers. See Bouvier at column 6, lines 14-16 and lines 62-65. As mentioned above, Bouvier merely describes options of several dialup Internet providers. A dialup Internet dial-up provider is a provider of Internet access. By contrast, the present application claims specifying telephone services for a particular caller. Furthermore, Bouvier at column 7, lines 9-31, does not even mention 'specifying a selection,' 'specifying a selection of services from among a plurality of services,' or 'specifying a selection of services from among a plurality of services that are offered for said call request according to said caller

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profile.' Because the additional citations to Bouvier in the Examiner's Answer do not disclose each and every element of the Applicants' claims, Bouvier does not anticipate the Applicants' claims, and the rejections should be withdrawn.

Bouvier Does Not Enable Each And
Every Element Of Claim 31

Not only must Bouvier disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Bouvier must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Bouvier places Applicants' claims in the possession of a person of ordinary skill in the art, Bouvier is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(e).

Bouvier does not place in possession of one of ordinary skill in the art independent claim 31 and is legally insufficient to anticipate Applicants' claims. Independent claim 31 of the present application claims:

31. A method for specifying telephone services for a particular caller, comprising:
- receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device;

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retrieving a caller profile for said authenticated caller identity; and

specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.

Bouvier Does Not Place In Possession Of One Of Ordinary Skill
In The Art Receiving, At An Intermediary Device, An Authenticated
Caller Identity For A Call Request From An Origin Device

The first element of claim 31 claims “receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device....” The Final Office Action relies on Bouvier at Figure 1, column 5, line 65 through column 6, line 13, in an effort to show that Bouvier place in possession of one of ordinary skill in the art the first element of claim 31. In response to the Final Office Action, the Appeal Brief explains that Figure 1 only illustrates that a public switched network, a public internet, a private intranet, and an extranet may coexist. The Appeal Brief further explained that Bouvier at column 5, line 65 through column 6, line 13, did not even address authenticated caller identities, call requests, or specifying telephone services for a particular caller. As such, Applicants argued in the Appeal Brief that Bouvier does not place in possession of one of ordinary skill in the art each and every element of claim 31 and the rejection should be withdrawn.

The Examiner’s Answer at page 9 responds to the arguments in the Appeal Brief regarding the first element of claim 31 stating:

On pages 10 and 11 of the Appeal Brief, the Appellant contends that Figure 1 does not disclose receiving, at an intermediary device, an authenticated caller identify for a call request from an origin device as claimed in the present invention. Examiner respectfully disagrees with this argument. The Appellant didn’t claim the actual physical location of intermediary device and origin device. The service control subsystem of

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Bouvier reads on the claimed 'intermediary device' and the customer telephone reads on the claimed 'origin device.' It is because, the service control subsystem receives a Personal Identification Number (PIN) for a call request from a customer telephone (col.5, line 65-col. 6., line 13, col. 7, lines 9-31).

That is, the Examiner's Answer now argues that Bouvier at column 7, lines 9-31, discloses the first element of claim 31. Applicants respectfully note in response, however, that Bouvier at column 7, lines 9-31, in fact discloses:

The application first initiates a user identification or authentication procedure to verify the identity of the calling party. Different procedures may be used. In one embodiment, the SCP issues a ConnectToResource message to the switch requesting that the calling user be connected to an Intelligent Peripheral (IP). A further 'PromptAndCollectUserInformation' message is sent to the switch in accordance with the Core INAP protocol to collect the user's subscriber number and the PIN code. The information collected is returned back to the SCP in a TCAP result message where a lookup is done in database 50 to check the subscriber number and PIN code against a list of valid pairings. Alternatively, the user authentication may use a procedure based on a calling card. In this case, the calling party is identified by the calling card used, and the billing charge for the connection will be charged to that calling card. In this case, the calling card number will be retrieved using specific calling card reading equipment, although the calling party may still be requested to enter a PIN number.

Once the SCP has authenticated the calling user, the User Access options (user profile) that is contained in the centralised database 50 is retrieved by the application.

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That is, Bouvier at column 7, lines 9-31, discloses authenticating a user using a PIN or calling card and retrieving user access options from a database. Bouvier's authenticating a user using a PIN or calling card and retrieving user access options from a database is not receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device as claimed in the present application. In fact, Bouvier at column 7, lines 9-31, does not even mention 'an intermediary device,' 'an authenticated caller identity,' or 'receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device.' Because the additional citation to Bouvier in the Examiner's Answer do not place in possession of one of ordinary skill in the art each and every element of the Applicants' claims, Bouvier does not anticipate the Applicants' claims, and the rejections should be withdrawn.

In addition to citing Bouvier at column 7, lines 9-31, the Examiner's Answer argues above that a service control subsystem ('SCP') is an intermediary device as claimed in the present application. The service control subsystem of Bouvier, however, is not an intermediary device as claimed in the present application. Bouvier at column 7, lines 9-31, describes the SCP as receiving PIN numbers used to authenticate a calling user—not receiving an authenticated caller identity for a call request from an origin device. That is, the SCP of Bouvier receives only PIN numbers used to authenticate, the SCP of Bouvier does not receive an already authenticated caller identity for a call request from an origin device. Because the additional citation to Bouvier in the Examiner's Answer do not place in possession of one of ordinary skill in the art each and every element of the Applicants' claims, Bouvier does not anticipate the Applicants' claims, and the rejections should be withdrawn.

**Bouvier Does Not Place In Possession Of One Of Ordinary Skill In The
Art Specifying A Selection Of Services From Among A Plurality Of Services
That Are Offered For Said Call Request According To Said Caller Profile**

The third element of claim 31 claims "specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile."

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The Final Office Action relies on Bouvier at column 6, lines 11-16, and the theory of inherency to place in possession of one of ordinary skill in the art the third element of claim 31. In response to the Final Office Action, the Appeal Brief explains that column 6, lines 11-16, is a general description of identifying a particular customer and retrieving a customer profile that does not even address services offered for a call request or specifying telephone services for a particular caller at all. The Appeal Brief further explains that the Final Office Action cannot rely on the theory of inherency to disclose the third element of claim 31 because the Final Office Action does not provide the required analysis under *Ex parte Levy* to support a rejection on the theory of inherency. 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990). As such, Bouvier does not place in possession of one of ordinary skill in the art each and every element of claim 31 and the rejection should be withdrawn.

The Examiner's Answer at pages 7 and 8 responds to the arguments in the Appeal Brief regarding the first element of claim 31 stating:

Since user is provided with different access options through telephone from which he/she can make a choice and each of user's choice corresponds to a network access server (col. 7, lines 39-50), the 'different access option though telephone' is the claimed 'specifying telephone services.' Thus the rejection of the claims in view of Bouvier is proper.

That is, the Examiner's Answer now argues that Bouvier at column 7, lines 39-50, discloses the third element of claim 31 in the present application. Applicants respectfully note in response, however, that Bouvier at column 7, lines 39-50, in fact discloses:

The different options that are available are then presented to the user. This is achieved by means of the 'PromptAndCollectUserInfo' message sent by the application to the switch. This message causes the switch to instruct an Intelligent Peripheral (IP) to present the user with the different access options which the customer may choose. The user chooses which

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option he/she wants and the choice of the user is returned back to the application by means of a TCAP result message. The application running on the SCP will map the user's choice onto a real phone number corresponding to a network access server of a particular access service provider.

That is, Bouvier at column 7, lines 39-50, discloses presenting a user with possible dialup Internet providers and mapping the user to one of the dialup Internet providers. Bouvier's presenting a user with possible dialup Internet providers and mapping the user to one of the dialup Internet service providers is not specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile according to embodiments of the present invention. Bouvier at column 7, lines 39-50, merely describes connecting a user to one of several dialup Internet providers. A dialup Internet dial-up provider is a provider of Internet access. By contrast, the present application claims specifying telephone services for a particular caller. In addition to not disclosing specifying telephone services of the present application, Bouvier at column 7, lines 39-50, does not mention 'a caller profile' or 'specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.' Because the additional citations to Bouvier in the Examiner's Answer do not place in possession of one of ordinary skill in the art each and every element of the Applicants' claims, Bouvier does not anticipate the Applicants' claims, and the rejections should be withdrawn.

The Examiner's Answer at page 8 also responds to the arguments in the Appeal Brief regarding the first element of claim 31 stating:

On page 6, of the Appeal Brief, the Appellant further contends that the cited sections of Bouvier do not even address authenticated caller identities, call requests, or specifying telephone services for a particular caller at all. Examiner respectfully disagrees with this argument. Bouvier teaches that a particular customer is identified by his PIN and his profile is

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retrieved after being identified by SCP of service control subsystem (col. 6, lines 7-16, col. 7, lines 9-31).

That is, the Examiner's Answer now argues that Bouvier at column 7, lines 9-31, discloses the third element of claim 31 in the present application. Applicants respectfully note in response, however, that Bouvier at column 7, lines 9-31, in fact discloses:

The application first initiates a user identification or authentication procedure to verify the identity of the calling party. Different procedures may be used. In one embodiment, the SCP issues a ConnectToResource message to the switch requesting that the calling user be connected to an Intelligent Peripheral (IP). A further 'PromptAndCollectUserInformation' message is sent to the switch in accordance with the Core INAP protocol to collect the user's subscriber number and the PIN code. The information collected is returned back to the SCP in a TCAP result message where a lookup is done in database 50 to check the subscriber number and PIN code against a list of valid pairings. Alternatively, the user authentication may use a procedure based on a calling card. In this case, the calling party is identified by the calling card used, and the billing charge for the connection will be charged to that calling card. In this case, the calling card number will be retrieved using specific calling card reading equipment, although the calling party may still be requested to enter a PIN number.

Once the SCP has authenticated the calling user, the User Access options (user profile) that is contained in the centralised database 50 is retrieved by the application.

That is, Bouvier at column 7, lines 9-31, discloses authenticating a user using a PIN or calling card and retrieving user access options from a database. Bouvier's authenticating a user using a PIN or calling card and retrieving user access options from a database is

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not is not specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile according to embodiments of the present invention. The user access options of Bouvier are dialup Internet providers. *See* Bouvier at column 6, lines 14-16 and lines 62-65. As mentioned above, Bouvier merely describes options of several dialup Internet providers. A dialup Internet dial-up provider is a provider of Internet access. By contrast, the present application claims specifying telephone services for a particular caller. Furthermore, Bouvier at column 7, lines 9-31, does not even mention 'specifying a selection,' 'specifying a selection of services from among a plurality of services,' or 'specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.' Because the additional citations to Bouvier in the Examiner's Answer do not place in possession of one of ordinary skill in the art each and every element of the Applicants' claims, Bouvier does not anticipate the Applicants' claims, and the rejections should be withdrawn.

Relations Among Claims

Independent claim 31 is patentable for the reasons discussed above. Independent claim 35 claims system aspects of the method claimed in independent claim 31. Independent claim 39 claims computer program product aspects of the method claimed in independent claim 31. Independent claims 35 and 39 therefore are patentable for the same reasons that independent claim 31 is patentable as described above. Dependent claims 33, 37, and 40 depend from independent claims 31, 35, and 39, respectively. The dependent claims include each and every element and limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand. Claims 31, 33, 35, 37, 39, and 40 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 31, 33, 35, 37, 39, and 40.

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**SECOND NEW GROUND OF REJECTION: ADDITIONAL REFERENCES IN BOUVIER ARE
CITED IN THE EXAMINER'S ANSWER IN AN ATTEMPT TO CURE THE DEFICIENCIES OF
BOUVIER IN COMBINATION WITH MOSER TO ESTABLISH A PRIMA FACIE CASE OF
OBVIOUSNESS AGAINST CLAIMS 32 AND 36 ACCORDING TO 35 U.S.C. § 103**

Claims 32 and 36 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Bouvier (U.S. Patent No. 6,430,276) in view of Moser, *et al.* (U.S. Patent No. 6,556,127). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Bouvier and Moser. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Bouvier and Moser. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Bouvier and Moser must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

The Appeal Brief dated December 16, 2005 presented arguments that the combination of Bouvier and Moser does not establish a prima facie case of obviousness. The Appeal Brief demonstrated that the combination of Bouvier and Moser does not teach or suggest all of Applicants' claim limitations, that no reasonable expectation of success in the proposed combination of Bouvier and Moser exists, and that the Final Office Action did not point to a place in either Bouvier or Moser suggesting or motivating the combination of Bouvier and Moser as required under *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed Cir. 1997).

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In response to the Appeal Brief, the Examiner's Answer at page 12 cites an additional reference in Bouvier in an attempt to demonstrate that Bouvier suggests or motivates the combination of Bouvier and Moser stating:

On page 18 of the Appeal Brief, the Appellant further contends that "The above reference in the Office Action does not point to any specific teaching in either Bouvier or Moser suggesting such a modification or combination." The examiner respectfully disagrees with this argument. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bouvier provides the suggestion that the interaction between the user and the PSTN for authentication and access service selection involves directing voice messages to the user and voice feedback is collected from the user (col. 11, lines 27-30).

That is, the Examiner's Answer argues that Bouvier at column 11, lines 27-30, suggests or motivates that combination of Bouvier and Moser. Applicants respectfully note in response, however, that what Bouvier at column 11, lines 27-30, actually discloses is:

The interaction between the user and the PSTN for authentication and access service selection will generally involve connection to an IP where voice messages are directed to the user and voice/DTMF feedback is collected.

That is, Bouvier at column 11, lines 27-30, discloses a user responding to the voice messages of an intelligent peripheral using a telephone keypad or speaking responses to

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authenticate using a PIN. Bouvier's disclosure of a user responding to the voice messages of an intelligent peripheral ('IP') using a telephone keypad or speaking responses to authenticate using a PIN does not suggest or motivate the combination of Bouvier and Moser which teaches a completely different method of authentication using voice comparisons. In fact, the cited section makes no mention of combining Moser's speaker verification using voice comparisons with Bouvier's selecting a dialup Internet provider for a particular caller. Furthermore, there is no suggestion or motivation to combine Bouvier and Moser because Bouvier and Moser teach mutually exclusive methods of authentication—Bouvier discloses authentication using a PIN, while Moser discloses authentication using voice comparisons. Because the Examiner's Answer does not point to a teaching within either Bouvier or Moser suggesting or motivating the proposed combination of Bouvier and Moser, the proposed combination of Bouvier and Moser does not establish a *prima facie* case for obviousness, and the rejections of claims 32 and 36 should be withdrawn.

THIRD NEW GROUND OF REJECTION: ADDITIONAL REFERENCES IN BOUVIER ARE CITED IN THE EXAMINER'S ANSWER IN AN ATTEMPT TO CURE THE DEFICIENCIES OF BOUVIER IN COMBINATION WITH KAWAHARA TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS AGAINST CLAIMS 34, 38, AND 41 ACCORDING TO 35 U.S.C. § 103.

Claims 34, 38, and 41 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Bouvier (U.S. Patent No. 6,430,276) in view of Kawahara, *et al.* (U.S. Pub. No. 2002/0184096). To establish a *prima facie* case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a *prima facie* case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Bouvier and Kawahara. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a *prima facie* case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Bouvier and Kawahara. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a *prima facie* case of obviousness under 35 U.S.C. § 103 is that the proposed combination of

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Bouvier and Kawahara must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

The Appeal Brief dated December 16, 2005 presented arguments that the combination of Bouvier and Kawahara does not establish a *prima facie* case of obviousness. The Appeal Brief demonstrated that the combination of Bouvier and Kawahara does not teach or suggest all of Applicants' claim limitations, that no reasonable expectation of success in the proposed combination of Bouvier and Kawahara exists, and that the Final Office Action did not point to a place in either Bouvier or Kawahara suggesting or motivating the combination of Bouvier and Kawahara as required under *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed Cir. 1997).

In response to the Appeal Brief, the Examiner's Answer at page 13 cites an additional reference in Bouvier in an attempt to demonstrate that Bouvier suggests or motivates the combination of Bouvier and Kawahara stating:

On page 20 of the Appeal Brief, the Appellant further contends that "The above reference in the Office Action does not point to any specific teaching in either Bouvier or Kawahara suggesting such a modification or combination." The examiner respectfully disagrees with this argument. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bouvier provides the suggestion that after authenticating user SCP retrieves the user profile data over the internet 30 from the server 55 (fig.3; col.8; line64-col.9, line 13).

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That is, the Examiner's Answer argues that Bouvier at Figure 3 and column 8, line 64, through column 9, line 13, suggests or motivates that combination of Bouvier and Kawahara. Applicants respectfully note, however, that Bouvier at Figure 3 merely illustrates that an internet, a public switched telephone network ('PSTN'), a service control subsystem, customer equipment, a switching point ('SP'), and a service switching point ('SSP') may coexist. Bouvier at Figure 3 does not suggest or motivate the combination of Bouvier and Kawahara which discloses portable terminal devices for providing and obtaining advertising information. In fact, the cited section of Bouvier makes no mention of combining Kawahara's portable terminal devices for providing and obtaining advertising information with Bouvier's selecting a dialup Internet provider for a particular caller. Furthermore, there is no suggestion or motivation to combine Bouvier and Kawahara because Bouvier and Kawahara disclose complete different technologies—Kawahara discloses portable terminal devices for providing and obtaining advertising information that are unrelated to Bouvier's selecting a dialup Internet provider for a particular caller. Because the Examiner's Answer does not point to a teaching within either Bouvier or Kawahara suggesting or motivating the proposed combination of Bouvier and Kawahara, the proposed combination of Bouvier and Kawahara does not establish a prima facie case for obviousness, and the rejections of claims 34, 38, and 41 should be withdrawn.

Turning now to Bouvier at column 8, line 64, through column 9, line 13, Applicants respectfully note in response that what Bouvier at column 8, line 64, through column 9, line 13, actually discloses is:

With this general arrangement, the SCP first carries out user authentication--for example, by reference to information held in its local database 54--and then retrieves the user profile data over the internet 30 for use in querying the user as to the desired service and subsequent connection of the user to the appropriate network access server. The necessary address details of the server 55 could be stored in database 54 for each authorised user or obtained from user input; appropriate

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techniques are described in Applicants above-mentioned International Applications. The PSTN operator is preferably still responsible for billing both for use of the PSTN and the network accesses made by a user.

The server 55 is, for example, an enterprise server under the control of a particular enterprise and holding user profile data on the access rights of its employees to various network access servers (intranet/extranet/internet)

That is, Bouvier at column 8, line 64, through column 9, line 13, discloses a service control point that carries out user authentication and then retrieves user profile data over the internet from an enterprise server. Bouvier's disclosure of a service control point that carries out user authentication and then retrieves user profile data over the internet from an enterprise server does not suggest or motivate the combination of Bouvier and Kawahara which discloses portable terminal devices for providing and obtaining advertising information. In fact, the cited section of Bouvier makes no mention of combining Kawahara's portable terminal devices for providing and obtaining advertising information with Bouvier's selecting a dialup Internet provider for a particular caller. Furthermore, there is no suggestion or motivation to combine Bouvier and Kawahara because Bouvier and Kawahara disclose complete different technologies—Kawahara discloses portable terminal devices for providing and obtaining advertising information that are unrelated to Bouvier's selecting a dialup Internet provider for a particular caller. Because the Examiner's Answer does not point to a teaching within either Bouvier or Kawahara suggesting or motivating the proposed combination of Bouvier and Kawahara, the proposed combination of Bouvier and Kawahara does not establish a prima facie case for obviousness, and the rejections of claims 34, 38, and 41 should be withdrawn.

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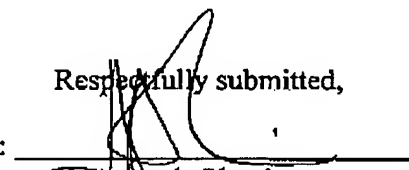
In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447
for any fees required or overpaid.

Date: May 16, 2006

By: _____

Respectfully submitted,


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APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, SERIAL NO. 10/015,381

CLAIMS

What is claimed is:

31. A method for specifying telephone services for a particular caller, comprising:
- receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device;
- retrieving a caller profile for said authenticated caller identity; and
- specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.
32. The method for specifying telephone services for a particular caller according to claim 31, wherein said authenticated caller identity is authenticated by a voice utterance of said caller.
33. The method for specifying telephone services for a particular caller according to claim 31, wherein retrieving a caller profile further comprises:
- retrieving said caller profile from a profile database within said intermediary device.

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34. The method for specifying telephone services for a particular caller according to claim 31, wherein retrieving a caller profile further comprises:
- retrieving said caller profile from a systems management server.
35. A system for specifying telephone services for a particular caller, comprising:
- an intermediary device communicatively connected to a telephone network;
- means for receiving, at said intermediary device, an authenticated caller identity for a call request from an origin device;
- means for retrieving a caller profile for said authenticated caller identity; and
- means for specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.
36. The system for specifying telephone services for a particular caller according to claim 35, wherein said authenticated caller identity is authenticated by a voice utterance of said caller.
37. The system for specifying telephone services for a particular caller according to claim 35, wherein retrieving a caller profile further comprises:
- means for retrieving said caller profile from a profile database within said intermediary device.
38. The system for specifying telephone services for a particular caller according to claim 35, wherein retrieving a caller profile further comprises:
- means for retrieving said caller profile from a systems management server.

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39. A computer program product for specifying telephone services for a particular caller, comprising:
- a recording medium;
- means, recorded on said recording medium, for receiving an authenticated caller identity for a call request from an origin device;
- means, recorded on said recording medium, for retrieving a caller profile for said authenticated caller identity; and
- means, recorded on said recording medium, for specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.
40. The computer program product for specifying telephone services for a particular caller according to claim 39, further comprising:
- means, recorded on said recording medium, for retrieving said caller profile from a profile database within said intermediary device.
41. The computer program product for specifying telephone services for a particular caller according to claim 39, further comprising:
- means, recorded on said recording medium, for retrieving said caller profile from a systems management server.

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**APPENDIX OF EVIDENCE
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, SERIAL NO. 10/015,381**

This is an evidence appendix in accordance with 37 CFR § 41.37(c)(1)(ix).

There is in this case no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132, nor is there in this case any other evidence entered by the examiner and relied upon by the appellants.

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RELATED PROCEEDINGS APPENDIX

This is a related proceedings appendix in accordance with 37 CFR § 41.37(c)(1)(x).
There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR § 41.37(c)(1)(ii).